

(Filed as NBI-855A) [Now, 76590]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re Application of :
Robert F. Gehan, *et al.* : Group Art Unit: 1761
Serial No. 09/761,322 : Examiner Lien Tran
Filed: January 16, 2001 :
For: NOVELTY COOKIE PRODUCT :

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Commissioner for Patents
P.O. Box 1450
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Sir:

Substitute Brief on Appeal

Kindly enter this Brief on Appeal in response to the Notification
mailed January 9, 2006.

This Brief on Appeal is submitted in triplicate.

Appellants request an Oral Hearing.

1. Real Party in Interest

The real party in interest is Kraft Foods Holdings, Inc.

2. Related Appeals and Interferences

There are no related appeals or interferences.

3. Status of Claims

Claims 1-13 are pending in this application.

Claims 1-13 are under appeal.

No claims have been allowed.

4. Status of Amendments

No amendments have been offered after the final rejection. An Appendix at the end of this Brief presents clean copies of the appealed claims, including those amended.

5. Summary of Claimed Subject Matter

It will be recalled that the invention provides a novelty cookie product which adds a dimension of entertainment to the already enjoyable experience of eating a sandwich cookie. There are a total of thirteen claims defining this invention, with two of these being independent. Claim 1 is directed to the product and claim 8 is directed to a method of making the product. While dependent on claim 1, claim 13 further brings out the novelty by setting out the method of use of the cookie.

The product of the invention as defined in claims 1 through 7, is believed to have special appeal to children, but has prompted behavior in adults similar to that of children. The preferred form of the cookie 10, shown in FIG. 1, has a front or top cake 12 having a representation of a television 18, including dial 20, on the outside surface with no clear picture on the screen. Inside, the cookie has a confection filling 16 and is backed by another cake 14. (Page 3, lines 10-13) The cake 14 has a suitable image 22, which when used in combination with the confection filling 16, presents a latent image that can be revealed by eating in the manner of the invention—namely, removing at least sufficient of the confection to at least partially remove the confection. (Page 3, lines 13-18)

To the children eating the cookies of the invention, this is a distinct pleasure--here is a cookie product specially made for them to split open and lick off the confection filling so that they can see the picture. Claim 13, which is dependent on claim 1, describes the method of use to take advantage of the novel latent image feature. (Page 2, lines 7-8; page 3, lines 15-16; page 6, last three lines)

FIG. 2 shows a cross section of the cookie of FIG. 1, taken along line 2-2. It will be seen that in this embodiment, cake 12 has an intaglio image 18 and cake 14 has an intaglio image 22. The image can be a relief or other three-dimensional or two-dimensional image. FIG. 3 illustrates one preferred form of the invention wherein a popular cartoon figure as it might appear when viewed on a television screen (Angelica of Rugrat fame) forms the image. (Page 3, lines 20-25)

Independent process claim 8 calls for the steps of: baking a cake 14 having a three-dimensional image 22 thereon and applying thereto, over the image 22, a layer of confection 16 to cover at least a portion of the image 22,

thereby forming a latent image that can be revealed by removing at least a portion of the confection 16. (Page 3, line 7 to page 4, line 10; page 6, lines 1-3)

Preferably, the image 22 will be one that is easily recognized by children and will provide them with a point of visual interest when the confection is removed. (Page 3, line 25 to page 4, line 2)

6. Grounds of Rejection to be Reviewed on Appeal

- A.** Claims 1-3, 5-9 and 11-13 have been rejected under 35 USC §103(a) as obvious from the Persson, Australian Patent No. 224 485 and Blaschke, *et al.*, U. S. Patent No. 6,312,743, references.
- B.** Claims 4 and 10 have also been rejected under 35 U.S.C. 103(a) as being unpatentable over Persson in view of Blaschke, *et al.*, above, but further in view of Pappas, *et al.*, U. S. Patent No. 5,534,281.

7. Argument

A. The Claims Define an Invention Which is Not Obvious From the Persson and Blaschke, *et al.*, References.

Claims 1-3, 5-9 and 11-13 have been rejected under 35 USC §103(a) as obvious from the Persson and Blaschke, *et al.*, references.

This rejection is respectfully traversed because there is no teaching to be found in the references themselves for making the combination, the references are not in fact combinable, and even if the references were combined, the combination would not result in the claimed cookie product that is simple to make with conventional equipment, yet is entertaining and engaging.

The examiner disagrees with appellants' position that the references are

not combinable. The examiner addresses this point by arguing that “[c]ookies and candy are common treats to children. Thus, what is playful and novel to one product is equally playful and novel to the other....Thus, having the teaching of Persson and Blaschke *et al*, it would have been obvious to one skilled in the art to incorporate the teaching of Persson in making the cookie of Blaschke *et al* to make an appealing cookie when such product is intended for children.” Appellants submit, however, that the above reasoning from the Office Action does not address the issue of how the references can be combined without changing their essential features and adding features shown or suggested by none.

Importantly, the mere fact that both cookies and candy can be made to be entertaining to children, does not explain how one skilled in the art knowing the teachings of Persson would address the issue of making the claimed cookie product using the specific teachings of Persson.

The product of Persson is quite different from both the product of the invention and that of the Blaschke *et al.* reference, with which the examiner proposes combining the teachings of Persson.

There are several distinct differences between the invention and what Persson shows. Among these are the facts that: (1) the “picture” of Persson is a flat, two-dimensional printed picture, (2) the Persson process requires separate equipment for both cookie (wafer) forming and candy forming and (3) the Persson process includes six distinct manipulative steps that the present invention does not and which cannot be accomplished on conventional cookie forming equipment. Appellant has provided a simplified process, which uses a three dimensional image and a different manner of hiding it, enables equipment to be eliminated, and enables processing steps and work to be reduced – all without affecting the entertainment value that might be

associated with a product of the type made by Persson.

The examiner states that “[t]he picture of Persson can resemble a television set; thus, the image can be in three dimensional form.” The reference, however, actually states that: “[t]he wafer and toffee may be shaped to resemble a television set and to make it apparent which is the side to be licked in order to disclose the picture.” This passage does not in any manner teach or suggest anything other than a two-dimensional picture, whatever the outer configuration of the composite wafer and toffee. The picture is flat and covered with a uniform coating. It is not three dimensional, with coating material deeper in recesses.

It will be recalled that Persson starts out with a toffee candy and then (a) forms “a recess or depression 11 in one surface only of each lollie”, (b) forms a wafer of the same thickness as the depth of the recess, (c) prints a two-dimensional image on the wafer with a specially formulated ink, (d) places the wafer 15 in the recess 11, (e) covers the wafer 15 with hard candy 14 (chosen so that the picture can be seen through it, a fact that would prevent the outer coating 18 from filling recesses in a three-dimensional image were they provided), and finally (f) covering the hard candy layer with a soft coating 18 of chocolate or ice cream which can be more readily dissolved than the candy 14. Persson prints a flat picture, covers it up with a continuous coating that continues to cover the picture even after it is revealed. The configuration of appellants’ claimed image is actively involved in its revelation. The image of Persson is two-dimensional and cannot play any active role.

The examiner also contends that appellants’ arguments that the Person process is not suitable for performance by convention cookie forming equipment, is not supported by any evidence. Appellants submit, however, that the person skilled in the art will be aware that cookie equipment has baking as

its key feature, and that the candy forming and assembling system of Persson cannot bake a cookie. The Persson process is all about forming a layered candy having a printed flat wafer insert embedded in a base toffee candy under two more layers of candy. Appellants believe that it is clear that this does not either teach or suggest the use of cookie equipment.

Appellants had also argued that the combination proposed by the examiner would fully change the product of Persson. In response, the examiner states that “[i]t is true that such conversion fully changes the product because cookie is different than candy.” The examiner also states that “[t]he question to be answered is that would such conversion have been obvious to one skilled in the art. It is the examiner’s position that such conversion would have been obvious to one skilled in the art when one wants to make a cookie product with playful feature which is intended to appeal to children.” Appellants point out, however, that this position is an improper basis for denying a patent to appellants because (1) it assumes that the reference would be read by a skilled worker as teaching cookies and (2) it disregards the processing and cookie structural differences noted above. Neither the conversion of the candy and two-dimensional cookie product of Persson to the three-dimensional cookie product of the invention, nor the process and product differences noted above would in any way be taught or suggested by Persson taken alone or with any of the other prior art cited.

The examiner cites *In re McLaughlin*, 170 U.S.P.Q. 209, as support for the use of hindsight in the Office Action. However, that case is not consistent with the facts in this one. There, the case against the appellant did “not include knowledge gleaned only from the appellant’s disclosure...” In the present case this is exactly what the rejection does.

The combination presented in the Office Action requires, impermissibly,

for the person of skill in the art having the Persson and Blaschke, *et al.*, references in front of him, to also have appellants' disclosure of the type of product, its component parts and its construction. Otherwise, the invention could not be made in the manner claimed. Absent appellants' teaching or suggestion, there would be no reason to modify any of the references or to combine any of them in any way. The Court of Appeals for the Federal Circuit has laid out the test of hindsight in numerous cases over the years, and the present set of fact falls squarely within the parameters they find as improper. In the case of *In re Anita Dembiczak, et al.*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), they state:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also *Graham*, 383 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing

together the prior art to defeat patentability--the essence of hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). In this case, the Board fell into the hindsight trap.

Appellants believe that the parallels are strong with this application and the *Dembiczak* case and the others cited therein. The invention as a whole must be evaluated in light of the fair teachings and suggestions provided by the references. In the present case, there is too much left to the imagination of the skilled worker to arrive at appellants' claimed invention, even were the person skilled in the art to find the noted references.

There is no reason why the person skilled in the art would start modifying the presumptively operable and satisfactory procedures to arrive at appellants' claimed invention – unless the person skilled in the art also had appellants' invention in front of him.

The invention is claimed from several perspectives: as a product, as a process of making and as a process of using. In addition, each of the dependent claims defines the invention in different terms. The claims do not stand or fall together.

Appellants point out that each difference between one claim and another requires looking at the claimed invention as a whole, not merely focusing on the new wording using the base claim as prior art. Each of the dependent claims adds a limitation that is intended to further define preferred aspects of the invention to further separated the invention there claimed from the teachings of the references and the propriety of combining them in a §103 rejection.

The unobviousness for any added feature of a claim must not be

evaluated separately for its "separate knockdown ability" against the "stonewall" of the prima facie case, *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976), but is considered together with all limitations, in determining whether the *invention as a whole* would have been obvious to a person of ordinary skill in the field of the invention.

Appellants believe that the distinctions of the various dependent claims not only establish why the claims should not be taken together, but why they are patentable individually over the art of record to be discussed below.

**B. The Claims Define an Invention Which is Not
Obvious From the Persson and Blaschke, *et al.*,
References, taken further in view of Pappas, *et al.***

Claims 4 and 10 are rejected also under 35 U.S.C. 103(a) as being unpatentable over Persson in view of Blaschke, *et al.*, but further in view of Pappas, *et al.*

This rejection is improper for the reasons given above and because the Pappas, *et al.*, reference does not cure any of the deficiencies of that prior combination.

The combination presented in the Office Action requires, impermissibly, for the person of skill in the art having the Persson, Blaschke, *et al.* and Pappas, *et al.* references in front of him, to also have appellants' disclosure of the type of product, its component parts and its construction. Nowhere in any of the references is a teaching of a product anything like that claimed or any reason why someone skilled in the art should produce one.

The invention is neither shown or rendered obvious by the prior art. It is creative and worthy of patent protection under the law. The fact that the

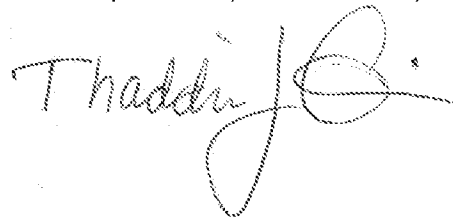
invention relates to a cookie intended for young people does not lessen the creativity required for its invention.

Conclusion

Appellant has made a significant improvement in cookie products by providing one that is simple to make with conventional equipment, yet is entertaining and engaging.

The invention is described in terms that clearly and patentably distinguish from the prior art of record. Accordingly, reversal of all rejections and allowance of all claims are believed in order.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Thaddius J. Carvis". The signature is written in dark ink and is positioned above a horizontal line.

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8. CLAIMS APPENDIX

APPEALED CLAIMS

1. (Amended 1/13/03) A novelty cookie product comprising a base cake having a three-dimensional image thereon and a layer of confection covering at least a portion of the image, thereby forming a latent image that can be revealed by removing at least a portion of the confection.
2. [Original] A cookie product according to claim 1 wherein the cookie product is a sandwich cookie having two base cakes separated by and adhered with a confection filling.
3. [Original] A cookie product according to claim 1 wherein the image on the base cake is three-dimensional.
4. (Amended 1/13/03) A cookie product according to claim 1 wherein the image on the base cake is formed by rotary molding to have a pattern of lands and recesses such that the confection, when partially removed at least partially fills in the recesses while it is removed from a portion of the image to make the image visible to a consumer.
5. [Original] A cookie product according to claim 1 wherein the confection is a sandwich cream comprised of fat and sugar.
6. [Original] A cookie product according to claim 1 wherein the image comprises a depiction of a cartoon character appearing on a television screen.

7. [Original] A cookie product according to claim 1 wherein the image comprises a depiction of a cartoon character appearing on a television screen, the confection is a sandwich cream comprised of fat and sugar and the confection is covered by a second base cake.
8. (Amended 1/13/03) A method of making a novelty cookie product comprising baking a base cake having a three-dimensional image thereon and applying thereto, over the image, a layer of confection to cover at least a portion of the image, thereby forming a latent image that can be revealed by removing at least a portion of the confection.
9. [Original] A method of making a novelty cookie product according to claim 8 which includes covering the confection with a second base cake to form a sandwich cookie.
10. [Original] A method of making a novelty cookie product according to claim 8 wherein the base cakes are formed by rotary molding to create three-dimensional images therein.
11. [Original] A method of making a novelty cookie product according to claim 8 wherein the confection is a sandwich cream comprised of fat and sugar.
12. [Original] A method of making a novelty cookie product according to claim 8 wherein the image comprises a depiction of a cartoon character appearing on a television screen.
13. [Original] A method of eating a novelty cookie product comprising

obtaining a cookie product as defined in claim 1 and removing a sufficient amount of the confection to reveal the image.

9. Evidence Appendix

There is no evidence outside of the specification submitted and relied upon.

10. Related Proceedings Appendix

There are no related proceedings.